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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,295	07/17/2003	Joel A. Drewes	MI22-2342	7253
21567	7590	05/24/2005	EXAMINER	
WELLS ST. JOHN P.S. 601 W. FIRST AVENUE, SUITE 1300 SPOKANE, WA 99201			KIELIN, ERIK J	
			ART UNIT	PAPER NUMBER
			2813	

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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20050522

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Commissioner for Patents

DETAILED ACTION

This action responds to the Amendment filed 14 March 2005.

Response to Amendment

1. The reply filed on 14 March 2005 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): SEE section entitled “*Election/Restrictions*” below for reasons and instructions. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Election/Restrictions

2. Applicant's election of the species A-1, B-1, C-1, E-1, F-1, and G-7 in the reply filed on 14 March 2005, with claims 1-5, 7-10 indicated to read thereon is gratefully acknowledged. Examiner acknowledges that the election is non-responsive with regard to the elected species. Applicant elected a first layer material of silicon dioxide (B-1) and a second layer material of silicon dioxide (C-1). This species is not enabled because the first layer and second layer cannot be selectively etched as required by claim 1, since the materials are the identical. The point in electing one from each of the lettered groups of mutually exclusive items is to *obtain a single combination of elements defining a species* for examination. This does not mean that other

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species will not be entitled to rejoinder so long as (1) they do not conflict with the allowed species, or (2) they properly depend from an allowed independent claim.

3. In order to be fully responsive, then, Applicant must still elect first and second layer materials that are actually enabled in the context of instant claim 1 --specifically that are selectively etchable and therefore are *not the same material*. Additionally, Applicant must still properly indicate which claims read on the elected species.

4. Applicant argues that claims 1-3 are generic. To be sure, they are not. Applicant continues to ignore the definition of a generic claim as recited in the MPEP 806.04(d), as explained in rather extensive detail in the previous Office action (filed 2 December 2004), as it applies to the instant claims. Any further response by Applicant in this regard should properly address how claims 1-3 can be generic in light of the definition given by MPEP 806.04(d) that does not also violate that which a generic claim is not, as given in MPEP 806.04(c). In this regard, a “mass” is not limited to the “memory bit” of claim 2; therefore claim 2 is not generic to claim 1. Similarly, CMP is not the only method of removing the undefined materials of the first and second layers from over an undefined mass, therefore claim 3 is not generic to claim 1. That Applicant wishes the claims 1-3 to be considered “broad enough to encompass all of the various species identified by the Examiner” does not negative the definition provided in MPEP 806.04(d) indicating to the contrary that at least claims 2 and 3 are not --by definition-- generic. Given the cancellation of the claims 11-77, claim 1 may be considered generic to the present claims. Should additional claims be added, the status of claim 1 as generic may not be maintained.

5. Applicant also opines that Examiner is somehow restricting the use of the word “mass.” Applicant should not think so because Examiner is not so suggesting. Examiner was only

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pointing out that the very clear ambiguity in the use of the term “mass” as an unidentified material or structure, when the only example of the “mass” given in the four corners of the instant application is that example where the mass is a magnetic memory bit. Further, because **none** of the materials of the layers or their structure is identified in claim 1, there exist virtually limitless inventions on which claim 1 may read. In regard to claim scope, it has been held that “The name of the game is the claim.” *In re Hiniker Co.*, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).” Accordingly, the search will be burdensome from the standpoint that the term “mass” can be anything under the sun, as well as the first layer and the second layer and the material subsequently disposed in the channel. In short, the breadth of claim 1 alone is so broad as to be burdensome for a thorough search. Accordingly the restriction to a single disclosed species is considered proper.

Information Disclosure Statement

The information disclosure statement filed 2 September 2003 has not been considered because it is illegible. Applicant is requested to use a larger font when listing the references in the IDS for faxing in the Office for clarity. This will also help to ensure proper citation of Applicant's listed references in any patent issuing from the instant application.

The information disclosure statement filed 2 September 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erik Kielin whose telephone number is 571-272-1693. The examiner can normally be reached from 9:00 - 19:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Whitehead, Jr. can be reached on 571-272-1702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Erik Kielin
Primary Examiner
May 21, 2005